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EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/883,913	OKI, HIROSHI	
	Examiner	Art Unit	
	Jean Janvier	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-16 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6/20/01.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should be descriptive and technically accurate so as to allow one of ordinary skills in the art understand the nature of the claimed invention.

Information Disclosure Statement

The NPL documents and the Japanese references were crossed off or not considered because English translated copies were not provided. Applicant is herein requested to supply appropriate English translated copies of the documents and references in a future correspondence.

Status of the claims

Claims 1-16 are now pending in the Instant Application.

Claim Objections

Claims 1-16 are objected because of the following informalities:

Throughout the claimed invention, " information-processing product" will be treated as a --client-software-- as supported in the background. Indeed, the example given in the technical field section, on page 1: 11-19, supports such interpretation and it appears that the specification

does not further define the "information-processing product".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have

found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson,* 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

> The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.,* the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma.* However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. In fact, the process or steps disclosed in independent claim 3

pertains to a manual process and therefore, the claim does not fall within the technological art. In other words, the steps or process of **storing use results... and calculating a payback value...,** as recited in the claim, should be implemented via a device, such as a computer system, a database, a data communication, computer network, the Internet and so and so forth.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer, US Patent 6, 148, 332A.

As per claims 1-16, Brewer discloses a **client software component (information product) for a personal computer** (PC) that interacts with a server of an Internet Service Provider (ISP) to require messages, such as advertisements, to be displayed in a particular manner on a display screen of the PC (information processing unit) for interaction with a user and reporting user activity (the server storage means stores in general the user's service usage of the Internet service and the user's interaction with the displayed advertisements). As long as a valid communication connection between the PC and the ISP exists, when the user logs in

subsequent to receiving and installing the ISP client software (information product) on his PC, the PC is forced to display a particular message (news, advertisement) in a particular fashion. A user will not be allowed to minimize the message, close the message, or hide the message behind other windows on the PC display screen. The messages will also be interactive so that users are able to get more information related to a particular displayed message, such as by automatically browsing to an associated location on the World Wide Web of the Internet (the user clicks on a hyperlink shown in a displayed message to visit the source of the message and request more information). Information related to interaction with the user is also tracked and communicated back to the ISP for storage and reporting (tracking and recording the user's activity and/or service use and storing the user's activity permanently in the server storage means). The user is also able to designate message selection criteria, such as expressing an interest in seeing certain types of advertisements. The system, as disclosed above, is configured to display messages on an identified or registered Internet client (PC) screen whenever an active connection exists between an Internet Server of the ISP and the said Internet client (See abstract).

In general, the present system, in a preferred embodiment, includes a mandatory message display and reporting modules that includes a new client software component for a personal computer (PC) interacting with a new server of an Internet Service Provider (ISP) to require certain messages, or information, to be displayed in a particular manner on a display screen of the PC or Internet client for interaction with a user and reporting user activity (col. 1: 45 to col. 2: 34).

The new software component (of the access software or information product) will also gather information related to interaction with the user. This information is communicated back to

the mandatory message server 100 of the ISP and stored thereon. Besides tracking which messages are actually displayed, user interaction tracking is also provided (service usage of the Internet service and/or the user's interaction or activity is recorded). In other words, as the user accesses additional information, i.e. browsing or hyper-linking to a particular source web site based by clicking on the mandatory message area or window or banner having the message displayed thereon, this act is recorded and communicated for storage at the mandatory message server 100 of the ISP. In addition to storing this type of user-specific message display and interaction history information (service usage), which is useful for billing the advertisers, the mandatory message server 100 maintains a database of messages categorized at least by user selection criteria (and including the data of the messages, associated URL's, etc.) and a database of user-specific message selection preferences. The temporary messages and the limited user display options are stored at the PC 10. It is further understood that the new software, which enables the user to connect to the ISP, is distributed to the user either electronically or online or on diskettes or CDs (having unique identifiers) via the Post Office (including other means) or through third parties or associated retailers POSes or checkouts (distributors) (col. 5: 5-22).

As per claims 1, 3, 4, 6, 9, 10, 12 and 14, although it is implicitly or silently supported in the Brewer's system that the client-software or product is encoded and distributed on a recorded medium (with a unique identifier) to the user either electronically or online or on diskettes (CDs) via the Post Office or through third parties or associated retailers POSes or checkouts (distributors), however, Brewer does not expressly disclose storing a distributor's name distributing an identified product and calculating or paying by the Internet (Network) Service

Provider (ISP) a fee to the distributor or participating retailer or third party for distributing the identified client-software or product (information-processing product) to the user(s) based on the user's information (recorded use information) identifying the user and the unique product.

However, the process for providing a Software or a product encoded on a computer readable medium (diskette or CD bearing a unique Product identifier) to a user or customer via a third party or distributor, which, when installed on the user's computer, allows the user to access an online distribution system or a computer network or Internet Service Provider (ISP) and for compensating the distributor for distributing the software to the user at a POS is well-established and well documented in the art. In fact, Internet Service Providers or ISPs, such as AOL.com (America Online), have been distributing free software encoded on 1.44 floppy diskettes (CDs) to selected users via the Post Office or physically picked up by the users at participating retailers' POSes or checkouts. The diskette containing the software or client provided by AOL.com, for example, bears a temporary login name and password or identification (including other product identifier). Upon installing the software, encoded on the diskette, on his computer, a user will be prompted to enter the temporary login name and password or identification, which allow the user to connect via a telephone line to a remote server associated with the ISP or AOL.com, wherein, upon validating the user's temporary information imprinted on the diskette, the user can complete the installation or registration process by providing his demographic data including a credit card number (user information) for future billing and establishing a permanent login name or screen name and a password or identification that are stored in the ISP server database. Subsequent to the installation or registration process, the user, now registered, can browse the

ISP site or visit other sites or web sites available on the Internet. Further, it is understood that AOL.com should compensate the distributors or third parties for distributing the diskettes or CDs, having the software encoded thereon, at their POSes or checkouts or locations in accordance with a predefined business agreement and wherein upon correlating the information received from the user's installation, such the temporary login name and password and other imprinted product id, with information in a registry or database file, AOL.com server is configured to identify the unique diskettes or products distributed by a specific distributor and calculate a compensation due to the distributor based on the business agreement.

. ("Official Notice").

(Similar information is disclosed in the background, page 2: 20-30, of the present Application).

Therefore, an ordinary skilled artisan, implementing the Brewer's system, would have been motivated at the time of the invention to combine the above public disclosure with the Brewer's system so as to distribute to users free diskettes or CDs, having the ISP client-software encoded thereon, via a distributor's or retailer's POS where the recordable media (diskettes or CDs) can be viewed and picked up by the users during the course of shopping and wherein each diskette or CD having imprinted thereon a user's temporary password and login name and other indicia that are used by the users during a sign-up process to complete the registration, thereby, providing a financial incentive to the distributor to display the diskettes or CDs, having encoded thereon the ISP sign-up software, near the checkout stations within his location where they can be easily picked up for free by interested users while paying for transactions at the distributor's

or retailer's POS in an effort to encourage the users to join the ISP network service, instead of a competitor's, for a monthly fee, and wherein identification data associated with a particular diskette or CD are read during the users' registration and are used not only to pay the distributor for a successful distribution, but also to measure the effectiveness of the distribution of the diskettes or CDs through third parties or independent distributors and the ISP is able to increase its subscriber base and business bottom line while compensations or money received by the distributor for giving away the recordable media, having the ISP client- software encoded thereon, to his customers are used to help cover overhead expenses.

Conclusion

Although the following references were not officially used in the Office Action, they were considered as relevant prior art. Applicants are further directed to review these references.

US Patent 6,377,936B1 to Henrick discloses a method of and a system for enabling targeted marketing of users on the Internet maintains the privacy of the users. The present invention takes advantage of the unique customer knowledge of an Internet Service Provider (ISP) with respect to both the customers identity and their likes and dislikes, while preserving the privacy of those customers. Data mining is performed on customers, including the sites that they visit. For example, customers with children are identified by visits to the Disney site. The availability of this list is then used to attract businesses with interest in this customer base. An

offer, perhaps with enticements such as coupons or contests, is prepared on a Web site. The ISP then makes the customer aware of that offer via an E-mail with short text describing that offer and a Hypertext link to that page. The customer is informed that they may take advantage of the offer and as a convenience and service to the customer and the advertiser, the ISP will provide their identity to the advertiser. Only when the customer selects the embedded URL is their identity disclosed. The ISP will then identify the customer to the advertiser by associating the customer's temporary IP address with their true identity as a service to the advertiser. Billing will be determined by both the total number of E-mails delivered and the number of responses generated.

US Patent 6, 442, 529 B1 to Krishan discloses a system for delivering targeted advertisements or messages, from a plurality of advertisers or sponsors, to identified users in a manner that does not interfere with the users' browsing session conducted over the Internet. The system includes at least one Internet Service Provider or ISP 24, referral service or advertising medium, offering subsidized or free Internet access (partial or full discount on Internet access) to users 22 who agree to read advertisements from advertisers 26 while the users' computers 50 of fig. 4 or terminals are in an idle mode or bandwidth use is low (See abstract; col. 3: 37 to col. 4: 45). Furthermore, free software provided along with a free modem by Portal Provider 20 in agreement with ISP 24 to users 22 so that the users can connect to the Internet via ISP 24 system and wherein the modem and software permit advertisements or messages from advertisers or sponsors to be displayed on the users' computers screens while dialing-up into the ISP system or server or while the Internet connection is idle (col. 5: 52-66; col. 16: 15-23). It is to be

understood that the revenue (compensations or fees or commission) earned by the ISP 24, advertising medium, for distributing advertisements from the advertisers or sponsors is used to offer subsidized or free Internet access (partial or full discount on Internet access) to users who agree to read advertisements from the advertisers.

US Patent 6,237,039B1 to Perlman discloses a method of and apparatus for downloading auxiliary data to a client during idle periods and for displaying the auxiliary data while the client is fetching information from the network is disclosed. According to one embodiment of the present invention, the state of a client device is first determined, wherein the client device is in a fetching state while processing a user request and the user is waiting or in an idle state while not processing a user request and the user is not waiting for the client system. Auxiliary data is then downloaded from a server to the client device when the step of determining determines that the client device is in an idle state. Additionally, the downloaded auxiliary data is buffered in an auxiliary buffer. The auxiliary data is then processed to generate an output and the output is displayed on the client device while the client device is in a fetching state.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719

In an effort to help advance prosecution, Applicant is encouraged to provide support, that is page and line numbers, for any amended or new claim submitted in the future.

06/1156/05 **Jean D. Janvier**

JDJ Patent Examiner

Art Unit 3622

JEAN D. JANVIER
PRIMARY EXAMINER